

REMARKS:

INTRODUCTION:

No new matter is being presented, and approval and entry of this Response is respectfully requested. Claims 1 – 12 are pending and under consideration. Reconsideration is respectfully requested.

ENTRY OF RESPONSE UNDER 37 C.F.R. §1.116:

Applicant requests entry of this Rule 116 Response and Request for Reconsideration because at least the primary reference applied to the claims is newly cited in the final Office Action, and Applicant should be provided the opportunity to present patentability arguments in view thereof. Furthermore, no claim amendments have been made.

The Manual of Patent Examining Procedures sets forth in §714.12 that "[a]ny amendment that would place the case either in condition for allowance or in better form for appeal may be entered." (Underlining added for emphasis) Moreover, §714.13 sets forth that "[t]he Proposed Amendment should be given sufficient consideration to determine whether the claims are in condition for allowance and/or whether the issues on appeal are simplified." The Manual of Patent Examining Procedures further articulates that the reason for any non-entry should be explained expressly in the Advisory Action.

Furthermore, pursuant to the Manual of Patent Examining Procedures §706.07(e), Applicant respectfully requests withdrawal of the "Final" Office Action designation. As noted above, the Final Office Action cited new references for an anticipation rejection under 35 U.S.C. §102, which could have been raised in previous Office Actions. Therefore, the Applicant respectfully requests withdrawal of the Final Office Action designation so responses to these new rejections can be entered and further responded to in the event of another Office Action.

REJECTION UNDER 35 U.S.C. §102:

In the Office Action, at page 2, numbered paragraph 3, claims 1, 2, 4 – 6, 8, 9, 11, and 12 were rejected under 35 U.S.C. §102(e) as being anticipated by the newly-cited Schuster et al. US. Patent No. 6,674,745 B1 (hereinafter "Schuster"). The reasons for the rejection are set forth in the Office Action and therefore not repeated. Claims 1, 4, and 8 are independent, and claims 2, 5, 6, 9, 11, and 12 are dependent. This rejection is traversed and reconsideration is requested.

In the Examiner's 35 U.S.C. §102 anticipation rejection of independent claims 1, 4, and 8, the Examiner relies on the Schuster reference to teach a telecommunication apparatus for initiating and receiving calls having a "gateway means for establishing a path between said first port and said second port inside said telecommunication apparatus in response to a request from a server on the packet based telecommunication network acting on behalf of a caller," as recited, for example, in claim 1. This feature of the present invention, however, is not disclosed by the Schuster reference. In contrast, the telephony device disclosed in Fig. 4 of Schuster teaches a processor, but this processor is not a gateway means. The Schuster reference teaches one port connected to the PSTN, but such a port would be used only for PSTN calls from and to the Internet telephone itself (col. 12, lines 31 to 36). There is nothing in the text or drawings of the Schuster reference that teaches or suggests the presence or desirability of a gateway means inside this telephony device that would create a path between the PSTN port and the IP network port.

The Examiner explains his reliance on the Schuster reference by stating: "(fig. 4 col. 9 [12], lines 49-58; noted the internet telephony device, operate in similar ways as ITG 30 in Fig. 2, wherein a path is create[d] between the PSTN interface and the IP network interface in response to a request to map a telephone number to an IP address from the AMS 40)". This explanation is not supported by the Schuster reference. The ITG 30 of Fig. 2 in Schuster is a conventional multi-line gateway device owned by a telephone company (col. 1, lines 51 -58 and col. 5, lines 11 - 26). The sole function of an ITG is to provide paths between a PSTN and an IP network. It does not receive or initiate calls. The Internet telephony device shown in Fig. 4 of the Schuster reference does not comprise any gateway means, but it is designed to receive and initiate calls. Therefore, the Internet telephony device and the ITG are separate and distinct devices within the Schuster reference, and accordingly, the two devices are NOT structured and do NOT operate in similar ways.

Furthermore, the Schuster reference may arguably teach the ability to self-register at an address mapping server (AMS). However, contrary to the reason for the address mapping in an ITG, the reason for the address mapping in the Internet telephone is only to allow a call with a dialed telephone number to be sent to the IP address of that particular telephone (col. 12, lines 46 – 48) and not to create a path between the two networks for usage by a third party. Therefore, the gateway means feature of the present invention, such as recited in independent claims 1, 4, and 8, is not taught or suggested by the Schuster reference.

In the Examiner's 35 U.S.C. §102 anticipation rejection of independent claims 4 and 8, the Examiner also relied on the Schuster reference to teach: "whereby said telecommunication apparatus can serve as a distributed gateway system between said circuit switched telecommunication system and said packet based telecommunication system." The Schuster reference also does not teach this feature of the present invention. The Schuster reference, instead, teaches away from this feature of the present invention. The IP telephony network taught by the Schuster reference discloses that all interconnections between an IP network and a PSTN are performed by the ITGs or SRITGs that are owned by the telephone company. Internal gateway means in Internet telephone devices as shown in Fig. 4 would be redundant, unnecessary, and undesirable for the typical user of the device taught by the Schuster reference. The Schuster reference only describes gateway traffic via "ITG" or "SRITG", which are centralized multi-line network gateways, and does not grasp the advantage of using an Internet telephone as part of a distributed gateway system. By including a gateway means inside each telecommunication apparatus, the present invention makes it possible to provide a truly distributed gateway system, independent of centralized multi-line gateways owned by a telephone company. This is an important improvement in the art.

In view of the foregoing, it is respectfully submitted that independent claims 1, 4, and 8 are patentably distinguishable over the prior art.

Claims 2, 5, 6, 9, 11, and 12 depend from claims 1, 4, and 8 and include all the features of claims 1, 4, and 8 plus additional features not taught or suggested by the prior art. Therefore, it is respectfully submitted that claims 2, 5, 6, 9, 11, and 12 are patentably distinguishable over the prior art.

REJECTION UNDER 35 U.S.C. §103:

In the Office Action, at pages 5 - 6, numbered paragraphs 5 - 6, claims 3, 7, and 10 were variously rejected under 35 U.S.C. §103 over Schuster in view of Chan et al., U.S. Patent 6,711,160 B2 (hereinafter "Chan"), or newly-cited Bhattacharya et al. U.S. Patent No. 6,353,610 B1 (hereinafter "Bhattacharya"). The reasons for the rejection are set forth in the Office Action and therefore not repeated. The rejection is traversed and reconsideration is requested.

Claims 3, 7, and 10 depend directly and indirectly on independent claims 1, 4, and 8, respectively, and include all the features of claims 1, 4, and 8 plus additional features not taught or suggested by the prior art. The Chan and Bhattacharya references do not teach the features

of the invention discussed above for independent claims 1, 4, and 8 that are missing in the newly-cited primary reference of Schuster, namely, gateway means inside the telephone devices. In fact, the Examiner does not apply and cite these secondary references to teach such features of the invention for either the dependent or the independent claims. Therefore, it is respectfully submitted that dependent claims 3, 7, and 10 are patentably distinguishable over the prior art.

CONCLUSION:

In accordance with the foregoing, it is respectfully submitted that all outstanding objections and rejections have been overcome and/or rendered moot. And further, that all pending claims patentably distinguish over the prior art. Thus, there being no further outstanding objections or rejections, the application is submitted as being in condition for allowance which action is earnestly solicited. At a minimum, this Amendment should be entered at least for purposes of Appeal as it either clarifies and/or narrows the issues for consideration by the Board.

If the Examiner has any remaining issues to be addressed, it is believed that prosecution can be expedited and possibly concluded by the Examiner contacting the undersigned attorney for a telephone interview to discuss any such remaining issues.

If there are any underpayments or overpayments of fees associated with the filing of this Amendment, please charge and/or credit the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: David M. Pitcher
David M. Pitcher
Registration No. 25,908

1201 New York Avenue, N.W.
Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501